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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/671,026

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Bruce Karsh

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HICKMAN PALERMO TRUONG & BECKER LLP/Yahoo! Inc.

2055 Gateway Place

Suite 550

San Jose, CA 95110-1083

EXAMINER

FRISBY, KESHA

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

06/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/671,026	Applicant(s) KARSH ET AL.	
	Examiner KESHA FRISBY	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-13 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/12/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

After the amendment was filed on 3/12/2008, claims 1-6, 8-13 & 15. Claims 7 & 14 were cancelled and claim 15 was newly added.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3, 4, 8, 10, 11 & 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Noble (U.S. Patent Number 6,729,882).

Referring to claims 1 & 8, Noble discloses receiving data that specifies a first form of a component word (Fig. 14 & the associated text & column 28 line 60 – column 12:

“blood” or “anti”); locating, within said compound word (Fig. 14 & the associated text & column 28 line 60 – column 12: “bloodhound” or “antihistamine”), a second form of said component word (“hound” or “histamine”) that differs from said first form of said component word (“hound” or “histamine” is different from “blood” or “anti”); and displaying said compound word with said second form of said component word visibly distinguished from the remainder of said compound word (in the compound words

"bloodhound" or "antihistamine", "blood" is visually distinguished from "hound" and the same rationale goes for "antihistamine").

Referring to claims 3 & 10, Noble discloses wherein said second form ("hound") of said compound word ("bloodhound") does not contain said first form ("blood") of said compound word ("bloodhound").

Referring to claims 4 & 11, Noble discloses determining a first stem word ("blood" or "anti") associated with said compound word ("bloodhound" or "antihistamine"); determining a second stem word ("hound" or "histamine") associated with said compound word; based on a comparison between letters in said first stem word and said compound word, determining a first starting position (starting with the letter "b" or "a"); based on a comparison between letters in said second stem word and said compound word, determining a second starting position (starting with the letter "h"); determining, based on said first starting position and said second starting position associated with said first stem word (starting with the letter "h"); and determining, based on said first starting position and said second starting position, an ending position associated with said first stem word (ending with the letter "d" or "i").

Referring to claim 15, Noble discloses wherein the steps of receiving, locating and displaying are performed by a search engine (Fig. 14 & the associated text).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 & 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noble in view of Van Aelten et al. (U.S. Patent Number 6,349,282).

Referring to claims 2 & 9, Noble discloses the limitations of claim 1 & 8. *Noble does not disclose wherein said second form of said compound word is a superlative form of said first form of said compound.* However, Van Aelten et al. teaches wherein said second form of said compound word is a superlative form of said first form of said compound word (column 6 lines 27-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include wherein said second form of said compound word is a superlative form of said first form of said compound word as disclosed by Van Aelten et al., incorporated into Noble in order disclose a superlative form of an adjective.

5. Claims 5, 6, 12 & 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noble in view of Hull et al. (U.S. Publication Number 2003/0187886).

Referring to claims 5, 6, 12 & 13, Noble discloses the method of claim 4 and claim 11. *Noble does not disclose wherein determining said first starting position comprises: determining, for a first sequence of letters in said compound word, a first score based on how many letters in said first sequence match letters in said first stem word; determining, for a second sequence of letters in said compound word, a second score based on how many letters in said second sequence match letters in said first stem word; and determining said first starting position based on said first score and said second score.* Noble also does not disclose wherein determining said second starting

position comprises: determining, for a third sequence of letters in said compound word, a third score based on how many letters in said third sequence match letters in said second stem word; determining, for a fourth sequence of letters in said compound word, a fourth score based on how many letters in said fourth sequence match letters in said second stem word; and determining said second starting position based on said third score and said fourth. However, Hull et al. teaches determining, for a first sequence of letters in said compound word, a first score based on how many letters in said first sequence match letters in said first stem word; determining, for a second sequence of letters in said compound word, a second score based on how many letters in said second sequence match letters in said first stem word; and determining said first starting position based on said first score and said second score (paragraphs 0030 & 0031). Hull et al. also teaches wherein determining said second starting position comprises: determining, for a third sequence of letters in said compound word, a third score based on how many letters in said third sequence match letters in said second stem word; determining, for a fourth sequence of letters in said compound word, a fourth score based on how many letters in said fourth sequence match letters in said second stem word; and determining said second starting position based on said third score and said fourth score (paragraphs 0030 & 0031). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include determining first, second, third and fourth sequences of letters, as well as, determining the first and second starting positions, as disclosed by Hull et al., incorporated into Noble in order to know where to start highlighting.

Response to Arguments

6. Applicant's arguments, see amended claims, filed 3/12/2008, with respect to 35 USC 101 have been fully considered and are persuasive. The rejection of 35 USC 101 has been withdrawn.

7. Applicant's arguments with respect to claims 1-6, 8-13 & 15 have been considered but are moot in view of the new ground(s) of rejection.

Citation of Pertinent Prior Art

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bass et al. (U.S. Patent Number 4,701,851) teaches compound word spelling verification.

Bass et al. (U.S. Patent Number 4,672,571) teaches compound word suitability for spelling verification.

Hofert et al. (U.S. Patent Number 5,337,233) teaches a method and apparatus for mapping multiple-byte characters to unique strings of ASCII characters for use in text retrieval.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KESHA FRISBY whose telephone number is (571)272-8774. The examiner can normally be reached on Monday-Friday 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. F./
Examiner, Art Unit 3714

/Ronald Laneau/
Supervisory Patent Examiner, Art Unit 3714
06/19/08